

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP ART UNIT: 1794

EXAMINER: Viren A. Thakur

In re application of: )  
Aaron Strand et al. )  
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Application No: 09/804,403 )  
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Filed: 03/12/2001 )  
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Confirmation No.: 1089 )  
 )  
Attorney Docket No. 8362-DIV )  
 )  
Customer No. 22922 )

For: A RESEALABLE BAG FOR  
FILLING WITH FOOD PRODUCT(S)  
AND METHOD

Commissioner for Patents  
Mail Stop Appeal Brief-Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

September 21, 2010

**Request For Rehearing Under 37 CFR § 41.52**

Appellant requests rehearing of the Board's decision stated to have been "Decided" on July 26, 2010<sup>1</sup> of which Appellant was notified of on July 26, 2010. This request is directed to points believed the Board misapprehended or overlooked. Since this request is being filed on or before September 26, 2010, it is timely.

**The Board Misstated The Issue On Appeal**

The issue on appeal is not whether Appellant has established "reversible error" on the part of the examiner. Slip op. at 5. Rather, the issue is whether the applied reference renders the subject matter of any of the claims on appeal as a whole obvious within the meaning of 35 U.S.C. § 103(a). In considering this issue, the Board must keep in mind

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<sup>1</sup> PTOL-90A Notification Date, per electronic filing.

that Appellant is entitled to a patent unless the PTO establishes reasons to the contrary. 35 U.S.C. § 102 (“A person shall be entitled to a patent unless--...”). Thus, the courts have made it clear that it is the examiner’s initial burden to establish a *prima facie* of unpatentability and if the examiner fails to do so, applicant is entitled to a patent without more. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

In phrasing the issue as it did the Board treats the examiner’s position as presumptively correct. Further, phrasing the issue in this manner fosters a piecemeal review of the record and the examiner’s rejection instead of the independent review of the examiner’s adverse decision contemplated by the statute. 35 U.S.C. § 6(b) (“The Board...shall...review adverse decisions of examiners upon applications for patents....”). Such a piecemeal review is not in accordance with the court’s instruction that patentability is determined based upon the totality of the record, taking into account persuasiveness of argument. For example, if the Board treats the examiner’s position as presumptively correct, how can the Board objectively review the record as a whole and objectively assess the persuasiveness of argument?

Further the Board’s citation of *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) and 37 CFR § 41.37(c)(1)(vii), slip op. at 4, do not support the proposition that Appellant “*must* show that the Examiner erred in finally rejecting the claims.” The cited rule only provides for the Argument section in the Appeal Brief and does not stand for the proposition that an appellant must show error. The portion of *Kahn* that is relied upon is a quotation from *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998) that indicates the Board is to review the entire position of the examiner, not just those portions that may be alleged to be in error. To put the cited proposition from *Kahn* in proper context, the entire referenced section of *Rouffet* must be considered. That portion reads:

To reject claims in an application under *section 103*, an examiner must show an un rebutted *prima facie* case of obviousness. See *In re Deuel*, 51 F.3d 1552, 1557, 34 U.S.P.Q.2D (BNA) 1210, 1214 (Fed. Cir. 1995). ***In the absence of a proper prima facie case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent.*** See *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2D (BNA) 1443, 1444 (Fed. Cir. 1992). On appeal to the Board,

an applicant **can** overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness. See *id.*

While this court reviews the Board's determination in light of the entire record, an applicant **may** specifically challenge an obviousness rejection by showing that the Board reached an incorrect conclusion of obviousness or that the Board based its obviousness determination on incorrect factual predicates.

*Id.* (emphases added) The use of permissive words such as “can” and “may” show that an appellant is not under the burden alleged in the commentary. Rather the Board must determine patentability based upon the entire record taking into account the arguments that appellant **may** make without any presumption of examiner correctness.

As will be developed below, the Board did not consider the record as a whole since the decision overlooks or ignores arguments made by Appellant and relies upon points not made by the examiner in the briefing. It is again urged that when the Board reviews this record using the proper standard, the only reasonable conclusion to be reached is that the examiner failed to carry the initial burden of establishing a *prima facie* case of obviousness. Thus, the rejections should be reversed.

#### The Board Improperly Shifted the Burden to Appellants

One of the issues on appeal is that "the Belmont et al. reference, alone or in combination with the Stolmeier et al. reference, does not teach or suggest a single sheet of web material, a fold, and areas of structural weakness located on opposite sides of the fold." (Reply Brief, p. 3).

The Appellants asserted in their Appeal Brief, pp. 20-21 that

Belmont et al. reference was cited as teaching a bottom-fill embodiment in Fig. 3C in which their fastener is located in the fold of the bag. However, the Belmont et al. reference does not include any areas of weakness in the portion of the bag that includes the fold. To attempt to overcome this deficiency, the Examiner added the Stolmeier et al. reference to the Belmont et al. reference to teach placing a hood formed in a tamper evident sheet 60 that is completely separate from the sidewalls 11 and 13 that constitute the material of the bag over a closeable closure 70. The hood of

the Stolmeier et al. reference has perforations 72 located therein that allow the hood to be torn off. The Examiner suggested that the perforations on the separate hood be moved to the side walls of the bag in the Belmont et al. reference. In so doing, the separate hood would be entirely eliminated.

The Examiner dismissed that argument as being not persuasive. (See page 13, Examiner's Answer). The Examiner states "Stolmeier teaches that it was conventional to provide a "hood" over a recloseable fastener track and then position a mechanism for facilitating removal of the hood, below the recloseable fastener tracks." (Pages 17 and 18 of Examiner's Answer).

Appellants submit that that combination as suggested by the Examiner, does not result in that which is disclosed and claimed in the present application where a single sheet of web material provides the fold and has areas of structural weakness located on opposite sides of the fold below the zipper mechanism. Appellants assert that one ordinarily skilled in the art would not place the second hood (as taught by Stolmeier) over the alleged hood of Belmont. The only teaching in Stolmeier for perforations is to use a completely separate piece of web material placed over a zipper mechanism. (See Fig. 7B of Stolmeier). There is no teaching or even a suggestion in Stolmeier that the perforations can be placed in the principal bag (elements 12 and 13 of Stolmeier). Accordingly, one ordinarily skilled in the art would not be compelled to add a second hood over the Belmont hood and/or place perforations in the principal bag of Belmont (elements 16 and 18, Fig. 3B) as suggested by the Examiner. The Board, in its analysis (pages 5, 6, and 7 of the Decision on Appeal) does not address the lack of the required element namely a single sheet of web material in the combination of the Belmont and Stolmeier references.

Appellants submit that on page 18 of the Examiner's Answer, the Examiner states "It is noted that Stolmeier et al. thus teaches that placing perforations below the recloseable fastener tracks has been a conventional location for placing lines of structural weakness for facilitating removal of the hood." The hood that Stolmeier refers to is the hood that is a separate sheet of material placed over the fastener tracks, not a hood

formed from a single sheet of web material as disclosed and claimed in the present application. Belmont does not teach perforations for opening the bag at all and Stolmeier teaches a separate, i.e. additional, hood material that has perforations. The Examiner's conclusory statement is not support by facts on the record.

The Boards' analysis ignores the fact that the combination of Belmont and Stolmeier does not teach or suggest a single sheet of web material, a fold, and areas of structural weakness located on opposite sides of the fold as disclosed and claimed in the present application. The KSR case, cited by the Board (page 6 of Decision on Appeal) requires that in formulating a rejection under 35 U.S.C. §103(a) based on a combination of prior art elements, it remains necessary to explicitly identify the reason why a person of ordinary skill in the art, properly defined, would have combined the prior art elements in the manner claimed. On the present record, the sole rationale contained in the Final Office Action, or the Examiner's Answer, for a combination of unrelated references is that each reference supplies something that is missing in the other.

The basis for the rejection in the Final Office Action is nothing like the analysis required by the Supreme Court in KSR; rather, the Examiner's basis is merely an assertion that the Belmont reference could be modified to provide a sheet of web material, a fold, and areas of structural weakness as disclosed and claimed in the present application. There is no cogent reason provided as to why someone having ordinary skill in the art, properly defined, would modify the Belmont reference in a manner that even the Examiner has not enumerated. The only teaching of Stolmeier is adding a separate, second web material with perforations to the bag. This is clearly not the analysis requires by KSR; there is neither the explicit analysis requires by KSR nor the identification of apparent reasons to make the modification, other than it would result in an advantage the Examiner attributes to the present invention.

The Final Office Action, Examiner's Answer nor the Decision on Appeal does not provide any reason or factual basis that one skilled in the art (undefined by the Examiner) would modify the Belmont reference to create the present invention as claimed, which is

required by well- settled case law. Since and proper and logically valid analysis has not clearly been performed by the Examiner, the Examiner has not presented a *prima facie* case of obviousness. Further, the Board has ignored the requirement that the recloseable bag of the present application requires a single sheet of web material that forms not only the bag but also the fold over the zipper mechanism and includes the perforations for removing the portion of the bag above the zipper material as disclosed and claimed in the present application.

The Board's Reliance Upon KSR as Inapposite

In discussing the KSR case, the Federal Circuit in Ortho McNeil Pharmaceuticals, Inc. v. Mylan Laboratories, Inc. et al., 520 F.3d 1358, 1364-65 (Fed. Cir. 2008), confirmed that a flexible TSM test *remains* the primary guarantor against a non-statutory hindsight analysis such as occurred in this case. (emphasis added)." According to the Court, "[t]he TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of *evidence* - teachings, suggestions (a tellingly broad term), or motivations (an equally broad term) - that arise before the time of invention as the statute requires (again, emphasis added)." *Id.*

The Board, on page 6 of the Decision on Appeal states "The question to be asked is "whether the improvement is more than the predictable use of prior art elements according to their established functions?" KSR, 550 US at 417." The Appellants submit that the "improvement" suggested by the Examiner is the use of a separate second sheet of material (with perforations) that is added to the Belmont bag. Appellants submit that such "improvement" is less than the predictable use of the prior art element since adding a second sheet of material is not what is required in the independent claims of the present application and eliminates a feature of the Stolmeier reference. Neither of the so-called "common sense" test or the TSM test articulated in the KSR case would be met by the Examiner's suggested combination of Belmont and Stolmeier because putting a second sheet of material on top of the alleged hood of Belmont would result in two hoods over

the zipper mechanism and the teaching of Stolmeier with perforations in that second hood material would not expose the zipper mechanism encased by the hood of Belmont.

The Board has not explained what factors are relied on to establish that a person ordinarily skilled in the art at the time of the invention would look to Stolmeier which teaches a separate second hood material which is contrary to that which is disclosed and claimed in the present application. Appellants submit that the lack of evidentiary support before the Board's determination is an indication that it is based on impermissible hindsight.

#### Conclusion

Appellants request that the Board reconsider its decision of July 26, 2010 and reverse the Examiner's rejection. In the alternative, the Board should answer each of the points made above and in so doing specifically explain why it believed the combination of Belmont and Stolmeier would result in that which is disclosed and claimed in the present application. To provide Appellants with procedural due process, the Board should either reverse the rejection of the Examiner and make a new ground of rejection under 37 CFR § 41.50(b) or denominate its decision on rehearing a new decision under 37 CFR § 41.52(a) and state that Appellants may file a second request for rehearing.

Respectfully submitted:

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